

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 249-336 (AMK)	
	Application Number	Filed	
	10/812,304	March 30, 2004	
	First Named Inventor <div style="text-align: center; padding: 5px;">Nakayama</div>		
	Art Unit	Examiner	
	3726	S. Afzali	

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor

☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)

☒ Attorney or agent of record 36,178
(Reg. No.)

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Registration number if acting under 37 C.F.R. § 1.34 _____

/Alan M. Kagen/
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January 2, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*

☒ *Total of 1 form/s are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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REASONS FOR REVIEW

With reference to the Office Action, the Examiner takes the position that the Kaiser publication meets the limitation in claim 10 reciting that the disc members comprise an inorganic fiber, mica and a clay having a content of particle size 5 μm or larger of not higher than 30% by weight based on the weight of the clay. In this context, it seems the Examiner is making an assumption that since Kaiser is silent with regard to particle components of its clay, it follows that the clay has no particle components (the Office Action suggests that the clay in Kaiser includes 0% particle components). Appellants respectfully submit that this characterization of the Kaiser publication is technically inaccurate. That is, it does not follow that a lack of specific disclosure in the Kaiser publication translates to disclosing the use of clay entirely without particle components. Rather, the impurity content of the clay in the Kaiser structure is not pertinent to its invention, and the percentage of particle components is simply not disclosed.

Without a specific disclosure relating to the impurity content of the clay in Kaiser, presumably it is the Examiner's contention that this feature of the invention is inherent in Kaiser. To the contrary, however, the Federal Circuit provided in *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991), that "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference and that it would be so recognized by persons of ordinary skill" (emphasis provided), citing *In re Oelrich*, 212 USPQ 323, 326 (C.C.P.A. 1981). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Hansgirk v. Kemmer*, 40 USPQ 665, 667 (C.C.P.A. 1939). It is clear that the construction of the disc members in Kaiser does not necessarily include clay entirely without particle components or of any particular impurity content.

The Office Action provides that "[i]n the alternative, if applicant believes that Kaiser et al. do not teach clay having no particle components, the Examiner considers the Applicant's disclosure (page 1, third paragraph, under Remarks/Arguments filed

2/27/2007) as admitted prior art, wherein the Applicant submits that clay naturally contains particle component.” The Examiner then concludes that it would have been obvious to provide the invention of Kaiser “with clay having naturally occurring particle components as taught by AAPA, in order to provide a disc roll comprised of desired and suitable material content.” Appellants respectfully disagree with this conclusion.

Appellants agree that clay naturally contains particle components. It is improper hindsight, however, to reach the conclusion in the Office Action that this fact meets or suggests the specific structure defined in claim 10. Neither Kaiser nor the AAPA even remotely discloses disc members that comprise an inorganic fiber, mica and a clay having a content of particles with a particle size of 5 μm or larger of not higher than 30% by weight based on the weight of the clay. Naturally occurring particle components in typical clay do not meet these criteria, and nothing in Kaiser or the AAPA suggests that this structure is known. The advantages and effects of this structure are described and demonstrated in the specification (e.g., see also Table 1B on page 32).

Appellants thus respectfully submit that the hindsight conclusion in the Office Action is improper, and withdrawal of the rejection is requested.

With regard to claim 21, in the grounds of rejection, the Office Action appears to merely repeat the grounds from the rejection of claim 10. Claim 21, however, does not define the same structure, and reference to such structure in rejecting claim 21 is of no consequence. Claim 21 rather recites, among other things, that the disc members comprise an inorganic fiber, mica and a clay, the clay being either elutriated or subjected to a wet sizing separation purification process. In this context, the Office Action disregards this structure of the invention, contending that “the patentability of the product does not depend on its method of production.” Appellants do not disagree with this statement; however, Appellants submit that claim 21 defines specific structure that is lacking in the references of record. Indeed, clay having been elutriated or subjected to a wet sizing separation purification process is **structurally** different from clay that has not been subjected to such procedures, which structural distinctions would be apparent to those of ordinary skill in the art. In addition, despite the Examiner’s contention that the specification lacks a discussion of structural effects of clay being elutriated or subjected to wet sizing, see, for example, page 20, lines 6-15 and Table

1B. As such, the clay defined in claim 21 has *structural* features that are distinguishable from Kaiser and the AAPA.

The Examiner's "Response to Arguments" illustrates the hindsight nature of the conclusions in the Office Action. Without support or a single teaching in any prior art reference, the Examiner concludes that the specifically defined materials set forth in the claims would merely have been obvious to "achieve a more uniform packing of clay particles and better interparticle binding resulting in a desired wear/attrition resistance." There is no basis in the prior art cited by the Examiner to support this conclusion. Moreover, at least the comments with regard to packing and binding are taken directly from Appellants' own disclosure. See, for example, page 11, lines 3-6, and page 19, lines 1-10.

Appellants thus respectfully submit that the rejections are misplaced.